

### **Remarks**

Claims 1, 3-7, 9-13, and 15-18 are currently pending in this application.

The final Office Action rejected claims 1, 3-7, 9-13, and 15-18 under 35 U.S.C. § 103(a) as being unpatentable over Wolfston, Jr. (U.S. Patent No. 5,815,155; hereinafter “Wolfston”) in view of Athletes & Coaches Choice, Inc. (hereinafter “ACCI”; November 28, 1999, retrieved from [www.archive.org/http://web.archive.org/web/19991128065521/http://accigameplan.com/](http://www.archive.org/http://web.archive.org/web/19991128065521/http://accigameplan.com/), on May 6, 2004). Applicant respectfully traverses the Section 103(a) rejection of claims 1, 3-7, 9-13, and 15-18, for the following reasons.

The present invention recited, for example, in claim 1 and claims 3-6 at least by virtue of dependence, comprises a combination of steps, including the steps of providing a searchable database of schools seeking to recruit athletes, wherein the searchable database includes information about numerous schools to enable the athletes to match their skills with schools seeking their specific skills; receiving a search query from a search criteria input system; and searching the searchable database to identify recruiting information associated with a set of schools matching the search query.

Further, the present invention recited, for example, in claim 7 and claims 9-12 at least by virtue of dependence, comprises a combination of instructions, including instructions for providing a searchable database of schools seeking to recruit athletes, wherein the searchable database includes information about numerous schools to enable the athletes to match their skills with schools seeking their specific skills, receiving a search query from a search criteria input system, and searching the searchable database to identify recruiting information associated with a set of schools matching the search query.

Finally, the present invention recited, for example, in claim 13 and claims 15-18 at least by virtue of dependence, comprises a combination of instructions, including instructions for providing a searchable database of schools seeking to recruit athletes, wherein the searchable database includes information about numerous schools to enable the athletes to match their skills with schools seeking their specific skills; receiving a search query from a search criteria input system; and searching the searchable database to identify recruiting information associated with a set of schools matching the search query.

Thus, the present invention is broadly drawn to, *inter alia*, a computer-implemented method, a system, and a computer readable medium that enables athletes to search a database of numerous schools to enable the athletes to match their skills with schools seeking their specific skills. The computer-implemented method, system, and computer readable medium of the present invention provides, in a single location (e.g., on a single web site), a searchable database that includes information about numerous schools to enable the athletes to match their skills with schools seeking their specific skills. The computer-implemented method, system, and computer readable medium of the present invention also provides, in a single location (e.g., on a single web site), the capability of receiving a search query from a search criteria input system, and the capability of searching the searchable database to identify recruiting information associated with a set of schools matching the search query. That is, the database, search query, and database searching of the present invention are all provided in a single location, and an athlete need not follow a hyperlink to another search engine to search the database or use the search query.

In contrast, Wolfston and ACCI fail to disclose or suggest a computer-implemented method, a system, and a computer readable medium that provides, in a single location (e.g., on a single web

site), a searchable database that includes information about numerous schools to enable the athletes to match their skills with schools seeking their specific skills, the capability of receiving a search query from a search criteria input system, and the capability of searching the searchable database to identify recruiting information associated with a set of schools matching the search query.

Wolfston merely discloses displaying information about schools matching search criteria inputted by users. Wolfston makes no mention of matching athletes with schools. The final Office Action and the Advisory Action of September 29, 2004 readily admit this. The final Office Action's reliance on ACCI for this disclosure is misplaced.

ACCI discloses a system where coaches can search for athletes but athletes *cannot* search, in a single location, a database containing school information that enables athletes to match their skills with schools seeking their skills. The "Find A College" section of ACCI (referenced at p. 7 of ACCI) does not provide a search engine in a single location, but rather provides students with hyperlinks to general school search engines (e.g., aol.com, embark.com, Princeton Review.com, etc.). That is, there is no database provided in the "Find A College" section. The "Find A Coach" section of ACCI (referenced at pp. 7-8 of ACCI) merely enables athletes to find a specific coach from a coaches database. This is entirely different than the database or searching disclosed and claimed in the present application, e.g., there is no matching of athletes' skills with schools seeking such skills in this section of ACCI. These sections of ACCI fail to disclose or suggest the claimed database containing school information that enables athletes to match their skills with schools seeking their specific skills. These sections of ACCI also fail to disclose or suggest the claimed search query and searching the database (containing school information that enables athletes to match their skills with schools seeking their specific skills) to identify recruiting information

associated with a set of schools matching the search query.

Furthermore, Applicant believes that the final Office Action and Advisory Action used impermissible hindsight to justify the combination of Wolfston and ACCI. There is no disclosure in either Wolfston or ACCI suggesting that these references may be combined. This alone makes the obviousness rejection improper. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929 (Fed. Cir. 1984) (obviousness cannot be established by combining the teachings of the prior art to produce the claimed inventions, absent some teaching, suggestion or incentive supporting the combination). The Federal Circuit strongly reiterated this point in *In re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). In *Sang Su Lee*, the Court held that the PTO must give full reasoning as to what motivation or teaching in the prior art would suggest combining references relied on in an obviousness rejection; and that an Examiner's general common knowledge and common sense do not substitute for the authority required by law to reject a claim for obviousness.

Without a motivation to combine these references, the Office Action relies upon the generalized statement "it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teachings of ACCI to Wolfston for allowing student athletes to search colleges for recruitment", in an attempt to combine the references. There is nothing in these references suggesting a computer-implemented method, a system, and a computer readable medium that enables athletes to search a database of numerous schools to enable the athletes to match their skills with schools seeking their specific skills, without reference to the present application. Thus, the Office Action's assertions merely represent the Examiner's general common knowledge and common sense. Such common knowledge and common sense cannot substitute for the authority

required by law to reject a claim for obviousness. In light of this, Applicant respectfully asserts that Wolfston and ACCI are not properly combinable.

In light of the above, Applicant respectfully asserts that Wolfston and ACCI, whether taken alone or in any reasonable combination (which is not possible because the references are not properly combinable), fail to disclose or suggest the claimed invention recited in claims 1, 3-7, 9-13, and 15-18. Applicant, therefore, respectfully requests reconsideration and withdrawal of the Section 103(a) rejection of these claims.

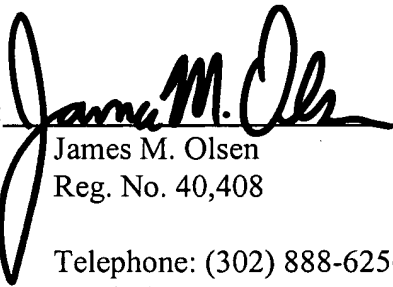
In view of the foregoing remarks, Applicant submits that the claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant, therefore, requests reconsideration of the application, and the timely allowance of the pending claims.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 03-2775. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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